

## REMARKS

Claims 1-12 remain in this application.

No claims are allowed.

Reconsideration of amended claims 1-12 is respectfully requested.

---

Paragraph 1 of the Examiner's communication objects to claim 12, and in response the claim is amended as pointed out by the Examiner.

Paragraphs 2, 3 and 4 of the Examiner's communication reject claims 1-12 as unpatentable over USP 6,584,197 to Boudreaux, Jr. et al in view of USP 4,730,311 to Carse et al, and further in view of USP 6,078,112 to Sanders et al.

Summary of USP 6,584,197 to Boudreaux, Jr. et al:

FIG. 1 of this patent to Boudreaux et al provides that utility-power 12 normally supplies power a power converter 30 that is connected to equipment subsystems 32.

In addition, a capacitor 60 stores energy from a local utility source 40 and its span 43.

Power availability for equipment subsystems 32 is monitored, and if the power from utility-power 12 is insufficient to maintain proper operation of equipment subsystems 32, the energy that is stored in capacitor 60 is supplied to equipment subsystems 32.

As stated at col. 4, lines 34-38, "As long as the local utility interface (10) and the wall transformer (11) are properly connected and operating normally, a main power converter 30 coupled thereto will supply regulated voltages for the terminal equipment's communication subsystems 32."

As stated at col. 4, lines 42,46, "However, if there is a failure or unacceptable reduction of the local utility power (12), a power limited converter 50 within the span interface unit 20 will be controlled, so as to increase power transfer from the central office (40) to the terminal equipment (32) and thereby maintain terminal equipment operation."

Summary of USP 4,730,311 to Carse et al:

This patent to Carse et al provides a multiplexer 18 in each of a plurality of subscriber locations 12 that electrically connect to a central office 14 by way of a subscriber loop 16 (col. 3, lines 40-59).

Multiplexer 18 is located at each subscriber location to support phone connections, high-speed modem-less data connections, and low-speed data connections.

Central office 14 does not supply power to multiplexer 18. Rather, power is supplied to multiplexer 18 from an AC power source 86 that is located at multiplexer 18.

As stated at col. 7, lines 28-48,

In case of power failure, a battery backup 88 provides DC power to the remote multiplexer 18. In the event of failure of local AC power 86, an AC power failure alarm 92 switches the power supply 90 to the battery backup 88.

When local AC power 86 fails, the remote multiplexer 18 alerts the central office 14 by an alarm signal developed by the alarm 92.

When the battery backup 88 loses its charge, as noted by an indicator 93, the remote multiplexer 18 discontinues transmission and service is lost until power is returned.

Summary of USP 6,078,112 to Sanders et al:

This patent to Sanders provides multi-purpose bays 12 that are used in computer systems.

Bays 12 may include batteries, storage media devices, such as disk drives, tape drives, etc., and other devices.

The computer systems may or may not include circuitry for hot-swapping of devices, and may or may not include circuitry for charging and/or discharging one or more batteries.

As stated at col. 4, lines 54-66, FIG. 1's multi-purpose bays 22 may hold a battery, and FIG. 1's docking station 10 may or may not include circuitry for discharging the battery, and may or may not include circuitry for controlling charging of the battery.

Argument for the patentability of claims 1-12:

Reconsideration of the patentability of amended claims 1-12 is respectfully requested.

It is true that the patent to Boudreau et al provides that;

(1) Power is normally provided to terminal-equipment-subsystems 32 by an AC wall-outlet 12, and

(2) When sensing-control unit 70 senses that the power from wall-outlet power 12 is insufficient,

(3) Power is supplied to terminal-equipment-subsystems 32 by telco 40.

It is true that the patent to Carse et al provides that:

(1) Each subscriber location 12 includes a local source of AC power 86 for supplying power to that location's multiplexer 18, and

(2) In the case of failure of AC power 86, a battery backup 88 provides DC power to the multiplexer 18, wherein

(3) In the case of failure of AC power 86, an AC power failure alarm 92 switches power from power supply 90 to battery backup 88, and power failure alarm 92 notifies central office 14 of this AC power failure, wherein

(4) Battery backup 88 losing its charge is noted by indicator 93, whereupon multiplexer 18 discontinuous transmission and service.

It is true that the patent to Sanders et al provides:

(1) A computer system having multi-purpose bay adapters 14;

(2) Which multi-purpose bay adapters 14 operatively receive devices such as batteries, media storage devices such as disk drives or tape drives, and other devices;

(3) Which computer system may or may not include circuitry for the hot-swapping of devices, and

(4) Which computer system may or may not include circuitry for charging and/or discharging one or more batteries.

It is respectfully submitted that the combined teachings of the Examiner's three citations do not suggest to those of ordinary skill in the art the subject matter of amended claims 1-12, absent the teachings of the present specification.

In other words, it is respectfully submitted that the Examiner has used the present specification in order to make a list of the various features that are found in claims 1-12, and has

then used this hindsight-knowledge to find three citations that include at least one of these features.

It is true that the patent to Boudreau et al provides that power is normally provided to a subsystem by way of an AC wall-outlet, and should this AC power become insufficient, power is then supplied to the subsystems by way of a telephone company to which the subsystem is connected.

It is also true that the patent to Carse et al provides that a multiplexer that is located at each subscriber location connects to a central office, a source of AC power at each subscriber location supplies power to that location's multiplexer, and in the case of failure of this AC power, a battery backup provides DC power to the multiplexer.

It is also true that the patent to Sanders et al provides that computer system may or may not include circuitry for the hot-swapping of devices.

Note that none of the Examiner's citations suggests the simplification-feature of the present invention wherein no on/off switch is provided.

In order for the Examiner to establish a prima facie case of obviousness, three basic criteria must be met.

(1) There must be some suggestion or motivation, either in the Examiner's citations themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a citation or to combine the citation-teachings;

(2) There must be a reasonable expectation that the Examiner's modification/combination will succeed; and

(3) The citations themselves must teach or suggest all rejected-claim limitations.

In addition, the teaching or suggestion to make the Examiner's modification/combination, and the reasonable expectation of success, must both be found in the citations, and cannot be based upon applicant's disclosure.

Stated in another way, in order for the Examiner's conclusion that the claimed invention is directed to obvious subject matter to be valid, the citations must expressly or impliedly suggest the claimed invention, or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the citations.

The mere fact that the citations can be combined or modified does not render the resulting combination obvious unless the prior art also suggests the desirability of the combination.

To prevent the Examiner's use of hindsight to defeat the patentability of any given invention, it is required that Examiner show motivation to combine the references that create the Examiner's case of obviousness. In other words, the Examiner must show reasons why the skilled artisan, confronted with the same problems, and with no knowledge of the claimed invention, would rebuild a citation in the manner suggested by the Examiner.

The best defense against a hindsight-based rejection by the Examiner is the rigorous application of the requirement to show a suggestion, a teaching, or motivation to combine prior art citations as was done by the Examiner.

A citation-by-citation, limitation-by-limitation, analysis by the Examiner must demonstrate how the citations teach or suggest their combination to yield the claimed invention.

It is respectfully submitted that while individual features of the present claimed invention may be old, only the present inventors have combined these features in the new, unusual and unobvious manner as defined in claims amended 1-12 of this application.

---

No claim related fees are believed to be due with this response. In the event any such fees are due, please debit Deposit Account 08-2623.

---

Reconsideration and allowance of this application is respectfully requested.

Respectfully submitted,

HOLLAND & HART LLP

By: 

Francis A. Sirr, Esq.  
Registration No. 17,265  
P.O. Box 8749  
Denver, Colorado 80201-8749  
(303) 473-2700, x2709

Date: 6/3/04  
3239308\_1.DOC